# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/458,896 | 12/10/1999 | MICHAEL C. BERTRAM | 533/038 | 9421 |

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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2665 | 20 |

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | **Application No.** | **Applicant(s)** |
|---|---|---|
| **Office Action Summary** | 09/458,896 | BERTRAM ET AL. |
| | **Examiner** | **Art Unit** | |
| | Michael J Molinari | 2665 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>20 January 2004</u>.

2a)☒ This action is **FINAL.**     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-14, 16, and 17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1.       The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.       Claim 1 recites the limitation "said navigational assets" in line 8.  There is insufficient

antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

1.       The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.       Claims 1-4, 7-11, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by

Norizuki et al. (U.S. Patent No. 5,570,361).

3.       Referring to claim 1, Norizuki et al. disclose in an information distribution system

providing content data and asset data comprising navigational information to at least one

subscriber, apparatus comprising: a NULL packet inserter (ATM Switch Unit, see column 7,

lines 5-9), for inserting NULL transport packets (idle cells) within a transport stream including

content packets (user information) (see column 7, lines 5-9); a transport processor (ATM Switch

Unit, see column 15, lines 29-31), for replacing at least some of said NULL packets with asset

packets comprising said navigational information (see column 15, lines 29-31.  The transport

information contains information about the path of the connection, and thus provides

navigational information. See also column 15, lines 36-41) comprising at least one of bitmaps

and control scripts (see column 15, lines 16-45, which shows that the traffic information is used

to make the control unit control the ATM switch unit), said navigational assets associated with

(The transport information is associated with the user information because it provides

information about the path that the user information is taking) said content packets (user

information) to produce a composite transport stream including content packets and asset packets

(see column 15, lines 29-31. The ATM switch replaces the empty data of an idle cell with useful

information, thus making the cell no longer an "idle" cell) having said navigational information

(see column 15, lines 29-41).

4.      Referring to claim 2, Norizuki et al. disclose a first transport packetizer (ATM Switch

Unit, see column 15, lines 29-31), for packetizing said asset data to produce said asset packets

(see column 15, lines 29-31 and note that the ATM switch unit maps the traffic parameters into

the cell, thus packetizing the asset data); and a second transport packetizer (ATM Switch Unit,

see column 7, lines 5-9, note that the ATM switch unit is the source of the user data),

cooperating with said NULL packet inserter, for packetizing said content data and producing said

transport stream including content packets.

5.      Referring to claim 3, Norizuki et al. disclose a storage means (buffer), coupled to said

transport processor, for storing said asset packets and said transport stream including content

packets and NULL packets (see column 8, lines 12-13). Also see Figures 29 and 30, which show

other buffers that also meet the limitations of this claim.

6.      Referring to claim 4, Norizuki et al. disclose a storage means (buffer), coupled to said

transport processor, for storing said asset packets and said transport stream including content

packets and NULL packets (see column 8, lines 12-13).

7.      Referring to claim 7, Norizuki et al. disclose that said second transport packetizer (ATM

Switch Unit, see column 7, lines 5-9) provides mapping data indicative of the location of NULL

packets within said transport stream including content packets and NULL packets (see Figures 4

and 5 and note that the idle cell (created by the ATM Switch Unit) contains different header

information that identifies it as an idle cell and that is used by the idle cell detector to identify the

cell as an idle cell. This information is used to identify the location of idle cells in the transport

stream).

8.      Referring to claim 8, Norizuki et al. disclose that said transport processor is responsive to

an asset rate control signal (idle cell rate) to adapt a utilization level of said NULL packets (see

column 7, lines 21-31).

9.      Referring to claim 9, disclose that said transport processor is responsive to an asset count

signal (counting value, see column 7, line 51) to replace a plurality of NULL packets with each

asset packet (see column 7, lines 42-58).

10.     Referring to claim 10, Norizuki et al. disclose in an information distribution system

providing content data and asset data comprising navigational information to at least one

subscriber, a method for processing content and asset information comprising the steps of:

inserting, within a transport stream including content packets (user information), a plurality of

NULL packets (idle cells); replacing at least some of said NULL packets with asset packets

comprising at least one of bitmaps and control scripts (see column 15, lines 16-45, which shows

that the traffic information is used to make the control unit control the ATM switch unit),

wherein said navigational information (see column 15, lines 29-31. The transport information

contains information about the path of the connection, and thus provides navigational

invormation. See also column 15, lines 36-41) are associated with (The transport information is

associated with the user information because it provides information about the path that the user

information is taking) said content packets (user information) to produce a composite transport

stream including content packets comprising said navigational information and asset packets (see

column 15, lines 29-31. The ATM switch replaces the empty data of an idle cell with useful

information, thus making the cell no longer an "idle" cell), wherein said navigational information

in said asset packets includes navigation imagery assets (see column 1, lines 29-40, note that

Norizuki et al. show that the application of their invention is intended for carrying multimedia

traffic).

11.      Referring to claim 11, Norizuki et al. disclose that said asset packets are processed

according to the steps of: packetizing, using a transport packetizer, at least one information

stream comprising an asset information stream (see column 15, lines 29-31), said asset

information stream being associated with a content stream (The transport information is

associated with the user information because it provides information about the path that the user

information is taking).

12.      Referring to claim 14, Norizuki et al. disclose the step of providing mapping data

indicative of the location of NULL packets within said transport stream including content

packets and NULL packets (see Figures 4 and 5 and note that the idle cell (created by the ATM

Switch Unit) contains different header information that identifies it as an idle cell and that is used

by the idle cell detector to identify the cell as an idle cell. This information is used to identify

the location of idle cells in the transport stream).

13.    Referring to claim 16, Norizuki et al. disclose that said step of inserting said asset packets

is repeated according to an asset injection count (counting value, see column 7, lines 42-58).

## *Claim Rejections - 35 USC § 103*

14.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.    Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norizuki

et al. (U.S. Patent No. 5,570,361) in view of LaJoie et al. (U.S. Patent No. 5,850,218).

16.    Referring to claims 5 and 17, Norizuki et al. disclose an apparatus as disclosed in claims

4 and 11. Norizuki et al. differ from the claims 5 and 17 in that they fail to disclose a session

controller for interacting with a subscriber to receive a content request and that causes both

transport streams to be provided to the transport processor. However, using session controllers

to receive requests from subscribers and to initiate the transmission of transport streams to be

delivered to said subscribers is well known in the art. For example, LaJoi et al. disclose such a

session controller (interactive cable gateway, Figure 1), which has the advantage of interacting

with subscribers to enable them to select and receive the content they wish to receive. One

skilled in the art would have recognized the advantage of enabling subscribers to select and

receive the content they wish to receive as taught by LaJoi et al. Therefore, it would have been

obvious to a person with ordinary skill in the art at the time of the invention to incorporate the

session controller as taught by LaJoi et al. into the invention of Norizuki et al. to achieve the

advantage of enabling subscribers to select and receive the content they wish to receive.

17.     Claims 6 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Norizuki et al. (U.S. Patent No. 5,570,361).

18.     Referring to claims 6 and 13, Norizuki et al. disclose that said plurality of NULL packets

to be inserted into said transport stream including content packets is determined with respect to a

certain condition (see column 7, lines 5-9, which discloses inserting a NULL packet when there

is no user cell to transmit). Norizuki et al. differ from claim 13 in that they fail to disclose a

specific signal that signals the lack of user information to be transmitted. However, the use of a

signal to indicate the lack of user data for transmission is well known in the art. For example,

Masaki et al. teach that the use of just such a signal (see column 2, lines 29-41) is conventional.

One skilled in the art would have recognized the advantage of using a signal to indicate the lack

of user information to be transmitted. Therefore, it would have been obvious to a person with

ordinary skill in the art at the time of the invention to incorporate the use of such a signal as

taught by Masaki et al. into the invention of Norizuki et al. to achieve the advantage of using a

conventional means of implementing an ATM switch capable of inserting idle cells into a

transport stream.

19.     Referring to claim 12, Norizuki et al. fail to disclose that said asset information stream

comprises a plurality of asset information sub-streams. However, the use of sub-streams within

data streams is old and well known in the art and has the advantage of providing more control

over data flows in a network. One skilled in the art at the time of the invention would have been

aware of the uses and advantages of sub-streams. Therefore, it would have been obvious to a

person with ordinary skill in the art at the time of the invention to incorporate the use of sub-

streams into the invention of Norizuki et al. to achieve the advantage of providing more control

over data flows in the network.

### *Allowable Subject Matter*

20.     Claim 15 is objected to as being dependent upon a rejected base claim, but would be

allowable if rewritten in independent form including all of the limitations of the base claim and

any intervening claims.

### *Response to Arguments*

21.     Applicant's arguments filed 20 January 2004 have been fully considered but they are not

persuasive.

22.     Applicant has argued that Norizuki et al. fail to teach "said navigational information

comprising at least one of bitmaps and control scripts, said navigational assets associated with

said content packets". However, the examiner has established in previous actions that the

navigational information taught by Norizuki et al. is associated with said content packets.

Regarding the navigational information, Norizuki et al. do teach in column 15, lines 29-45 that

the navigational information is used to control the ATM switch, which thus represents a control

script.

23.     In response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., facilitating

control and presentation of a navigational screen, which comprises menus for selecting various

programs) are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van*

*Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


## *Conclusion*

24.    **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.


Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742.

The examiner can normally be reached on Monday-Thursday 8am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Joseph Molinari

**ALPUS H. HSU**
**PRIMARY EXAMINER**